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File No.: T 0588/90 - 3.3.1
Application No.: 83 302 643.8
Publication No.: 0 094 250
Classification: C11D 3/00
Title of invention: Granules containing silicone-based anti-foam and a process for preparing them

D E C I S I O N
of 4 May 1993

Applicant: UNILEVER PLC, et al
Proprietor of the patent:
Opponent: Henkel Kommanditgesellschaft auf Aktien

Headword: Extent of opposition/UNILEVER
EPC: Art. 101, 102; R. 55(c)
Keyword: "Power to examine non-opposed subject-matter (no; following G 9/91)"

Headnote
Catchwords



Case Number: T 0588/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 4 May 1993

Appellant:
(Proprietor of the patent) UNILEVER PLC
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and

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Respondent:
(Opponent) Henkel
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Representative:

Decision under appeal: Decision of the Opposition Division of the
European Patent Office of 20 March 1990, posted on
17 May 1990, revoking European patent
No. 0 094 250 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: K.J.A. Jahn
Members: P. Krasa
J.-C. Saisset

Summary of Facts and Submissions

I. The mention of the grant of patent No. 0 094 250 in respect of European patent application No. 83 302 643.8, filed on 10 May 1983, was published on 30 July 1986 (cf. Bulletin 86/31) on the basis of eleven claims. Claims 1, 8, 9 and 11 read as follows:

"1. A process for the manufacture of granules containing a silicone-based antifoam which comprises the steps of:

- (a) forming a liquefied mixture of a silicone and a wax;
- (b) forming an agitated bed of a granular absorbent; and
- (c) spraying the liquefied mixture onto the absorbent,

characterised in that the wax is a water-insoluble wax.

8. A process according to any one of the preceding claims, characterised in that the water-insoluble wax has a melting point between 35 and 70°C.

9. A process according to claim 8, characterised in that the granular absorbent is gelatinised starch.

11. A process according to any claim 10, characterised in that the silicone is present in an amount of from 5 to 40%, the water-insoluble wax in an amount of from 5 to 30%, the absorbent in an amount from 20 to 80% and the nonionic surfactant in an amount up to 10% by weight of the granules."

II. A notice of opposition was filed on 30 March 1987 requesting revocation of the patent on the ground of lack of novelty and of inventive step of Claims 1 to 8 and 10 to 11. The opposition was, explicitly, not

directed against Claim 9 (the last sentence of the notice of opposition read "Der vorliegende Einspruch richtet sich jedoch nicht gegen diesen Anspruch 9.").

- III. By a decision delivered orally on 20 March 1990, with written reasons posted on 17 May 1990, the Opposition Division revoked the patent for lack of inventive step.
- IV. Notice and grounds of appeal were filed against this decision on 23 July 1990 and the appeal fee was paid on 24 July 1990. The Appellant (Patentee) requested that the decision under appeal be set aside and that the disputed patent be maintained in amended form on the basis of a new set of five claims.
- V. During oral proceedings, which took place on 4 May 1993, the Board explained that the amended Claim 1 might not be allowable under Article 123(2) EPC. The Appellant then requested the maintenance of the patent with a new set of four claims and a correspondingly adapted description (sole request).

New Claim 1 reads:

"A process for the manufacture of granules containing from 5 to 40% by weight of a silicone antifoam, from 5 to 30% of a water-insoluble paraffin or petroleum wax having a melting point within the range of from 35 to 70°C, from 20 to 80% by weight of a granular absorbent and optionally up to 10% by weight of a nonionic surfactant, the process being characterised by the steps of:

- (a) forming a liquified mixture of the silicone antifoam, the paraffin or petroleum wax and the optional nonionic surfactant, the mixture being free of organic solvent,

- (b) spraying the solvent-free liquified mixture onto an agitated bed of the granular absorbent,

the granular absorbent being gelatinised starch."

Claims 2 to 4 are dependent claims.

The Appellant submitted that the Opposition Division had indicated in the impugned decision that no objections arose against a claim similar to the above Claim 1 of the present request and that, thus, the appeal should be allowed.

- VI. The Respondent (Opponent), apart from agreeing to the formal admissibility of the new claims and description, did not comment and submitted no requests.
- VII. At the end of the oral proceedings the Chairman announced the decision of the Board to allow the appeal.

Reasons for the Decision

1. The appeal is admissible.
2. The current set of claims does not give rise to an objection under Article 123 EPC. This not being contested, no further comments are required.
3. New Claim 1 is in fact a combination of Claims 1, 9, and 11 as granted, the range of melting points of from 35 to 70°C being also a feature of Claim 9 as granted due to its dependence on Claim 8 as granted. As the limiting feature of Claim 9 as granted, i.e. the requirement that the granular absorbent is gelatinises starch, is now

also a mandatory feature of the present Claim 1, the scope of the latter claim does not extend beyond that of the former one.

For this reason, current Claim 1 covers only subject-matter which was not opposed (see above No. II), since the statement of the Respondent - then Opponent - that the opposition was not directed against Claim 9 can only be understood to mean that all subject-matter comprising the feature of this dependent claim, which refers back to Claim 1 via Claim 8, is excluded from the opposition. The same holds true for the dependent Claims 2 to 4.

4. In the decision G 09/91 of 31 March 1993 (see OJ EPO 1993, 408), the Enlarged Board of Appeal found that the EPO has no competence to deal in the opposition proceedings with non-opposed subject-matter of a European patent (No. 10 of the Reasons for the Decision). Hence, the Board finds, following the decision G 09/91, that it is not entitled to examine the patentability of the subject-matter of the pending set of claims, to which, according to Rule 55 lit. c) EPC, the opposition did not extend.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.

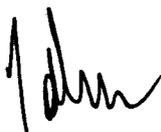
2. The case is remitted to the first instance with the order to maintain the patent with the Claims 1 to 4 and the description pages 1, 2, 2A, 3 and 4 as filed during the oral proceedings.

The Registrar:



E. Gorgmaier

The Chairman:



K.J.A. Jahn